

Appln. No.: 10/686,863
Amendment Dated October 3, 2007
Reply to Office Action of May 3, 2007

BSI-538US (formerly 021630-000522US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/686,863
Applicant: Michael V. Chobotov et al.
Filed: October 16, 2003
Title: DELIVERY SYSTEM AND METHOD FOR BIFURCATED GRAFT
TC/A.U.: 3738
Examiner: Thomas Sweet
Confirmation No.: 7447
Docket No.: BSI-538US (formerly 021630-000522US)

PETITION TO HAVE REQUIREMENT UNDER 35 C.F.R. 1.105 WITHDRAWN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to have the Requirement for Information under 35 C.F.R. 1.105 issued on May 3, 2007 withdrawn.

The May 3, 2007 Office Action requires under 35 C.F.R. 1.105 that Applicants identify all familial related co-pending applications and issued patents which disclose and claim very similar and/or identical subject matter to the present application. In Applicants' July 5, 2007 Response, it was respectfully submitted that the Information Disclosure Statement (IDS) filed on November 11, 2005 identified all familial related, co-pending applications, published applications and issued patents. Additionally, the Response dated July 5, 2007 identified published applications and issued patents that name Michael Chobotov or Brian Glynn as a inventor based on a search of the U.S.P.T.O. records.

The May 3, 2007 Office Action further requires under 35 C.F.R. 1.105 that Applicants "identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims." In a Notice of Non-Fully Responsive Reply dated August 24, 2007, this information was again requested. A Supplemental Response providing additional information has been submitted concurrently with this Petition.

To the extend the Supplemental Response is deemed to be not fully responsive, Applicants respectfully submit that this additional requirement in the May 3, 2007 Office Action (requiring Applicants to identify specific claims) is requesting information beyond that which is required under 37 CFR §1.105. As set forth in MPEP §704.11, 35 CFR 1.105 is drafted "to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR §1.105 are not requesting opinions that may be held or would be required to be formulated by applicant." (emphasis added). Identification of specific claims in those applications and/or patents which may present double patenting issues with the instant application claims is clearly opinion that would be required to be formulated, which is not required under 37 CFR §1.105.

Furthermore, 37 C.F.R. 1.105 states in pertinent part that:

In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, ...

(emphasis added). With the Applicants' identification of all familial related, co-pending applications, published applications and issued patents and the additional published applications and patents identified in the Response dated July 5, 2007, the Office has available to it all the information that is necessary to review the claims of the various applications and patents and make any double patenting determinations. In support of such, the May 3, 2007 Office Action includes an "example of double patenting." While it may be considered convenient and helpful to have the Applicants provide opinions as to which claims which may or may not present double patenting issues, convenience and helpfulness are not the standard. To the contrary, 37 C.F.R. 1.105 requires that the requested information be necessary to properly examine the matter. The Office is fully capable of examining the various claims and making determinations of double patenting. The required information is not necessary for the Office to proceed with such examination.

Since the Office Action is requesting information which is not necessary for examination and which is not factual information, but instead opinion which is not required under 37 C.F.R. §1.105, and to any extent that Applicants' Supplemental Response is not

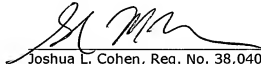
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deemed to be fully responsive, Applicants respectfully submit that the Requirement under 35 C.F.R. 1.105 is improper and should be withdrawn.

Applicants respectfully request withdrawal of the Requirement for Information Under 35 C.F.R. 1.105 set forth in the May 3, 2007 Office Action.

Respectfully submitted,



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Dated: October 3, 2007